

REMARKS

Claims 1-24 are pending in the above-identified application. Claims 1-24 were rejected. With this amendment independent claims 1, 9, and 17 were amended. Accordingly, claims 1-24 are at issue.

I. 35 U.S.C §103(a) Obviousness Rejection of Claims

Claims 1-3, 5-11, 13-19, and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Sragner* (U.S. Patent No. 6,272,485). Claims 4, 12, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Sragner* in view of *Oprescu-Surcode* (U.S. Patent No. 6,356,961). Applicants respectfully traverse these rejections in light of the current amendment and respectfully request reconsideration.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2143.

The rejection of claim 1, under §103(a) is improper as *Sragner* does not teach or suggest all of the claim limitations. *Sragner* does not teach or suggest a “disconnected device, wherein the disconnected device is a portable electronic device capable of performing computations at any location.” The Examiner’s characterization of the remote terminal in *Sragner* as a “disconnected device” is inconsistent with the description and characterization of a “disconnected device” as stated in the specification, for example, and the claims. See, for example, page 2, lines 15-18 of the specification. *Sragner* does not teach or suggest mobile or portable electronic devices capable of performing computations in any location. The remote terminal of *Sragner* when unplugged or turned off is not consistent with the proper claim interpretation of claim 1 as currently amended. Accordingly, *Sragner* fails to teach or suggest all of the claim limitations of claim 1 as is required under §103(a). Furthermore, no motivation or suggestion to modify *Sragner* has been offered by the Examiner. The *prima facie* case of

obviousness requires a reasonable expectation of success. Absent some teaching, suggestion, or incentive supporting such a modification, obviousness under §103(a) cannot be established. For at least these reasons, the rejection must fail.

The Examiner improperly interprets the “determining” limitation of claim 1, for example. Claim 1 recites, “Determining one or more modifications between said original document and said modified document.” The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Sragner* and include the “determining” limitation since the act of entering data into a data field by a user suggests the user determined a modification prior to actually modifying the document. Applicants respectfully disagree with the Examiner’s conclusion. The “determining” limitation automatically requires *the method as executed by the said computer* to determine whether a *previous* modification between the original and modified document has occurred. The Examiner incorrectly combines the mental process of a user occurring prior to an actual modification taking place with *Sragner* to reject claim 1. The “determining” limitation of claim 1 describes a methodology conducted by the computer after a modification has occurred. The concept asserted by the Examiner and the limitation presented in claim 1 are distinct. In an effort to expedite the allowance of claim 1 and to clarify Applicants’ intent, claim 1 has been amended to add “by said computer” to the “determining” limitation. For at least these reasons, Applicants contend claim 1 as amended is in condition for allowance and requests the rejection be withdrawn.

Concerning the rejection of claim 4, the Examiner argues that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined *Oprescu-Surcode* into *Sragner* for expanding the use of different computer-based devices. The Applicants respectfully disagree. *Oprescu-Surcode* does not teach or suggest “determining by said computer one or more modifications between said original document and said modified document,” as recited in claim 1, for example. The file size comparison conducted by *Oprescu-Surcode* is accomplished at the “source device” and not the “said computer” as recited, for example, in claim 1. See, *Oprescu-Surcode*, col. 7, lines 19-23. In the Office Action dated January 13, 2005, the Examiner admits that *Sragner* fails to teach or suggest determining one or more modification between said original document and said modified document.” *Oprescu-*

Surcode's file comparison at the source device fails to rectify *Sragner*'s deficiency. As *Sragner* in view of *Oprescu-Surcode* fails to teach or suggest all of the claim limitations, the rejection must fail. Furthermore, the Examiner fails to identify any motivation or suggestion to combine the *Sragner* and *Oprescu-Surcode* nor does he offer any evidence of a reasonable expectation of success from such a combination. Lacking such a suggestion or expressed expectation of success the rejection must fail. For at least these reasons the Applicants request the rejection be withdrawn.

Sragner in view of *Oprescu-Surcode* are not properly combinable references. *Oprescu-Surcode* teaches minimizing electronic transmissions by selecting the smallest amount of data and control information necessary to generate an edited version of a document at a destination device. See, *Oprescu-Surcode*, col. 7, lines 19-23. Claim 1 of *Oprescu-Surcode*, for example, recites a method for transferring the original document to the disconnected device, modifying the document at the disconnected device, and returning either the document from the disconnected device or the editing commands from the disconnected device based on the edited documents size. *Sragner* teaches away from *Oprescu-Surcode* by storing documents on a network server in multiple formats to minimize data transference. By storing a document in multiple formats on a server, *Sragner* enables destination devices to minimize the number of applications they must maintain and only transfer data associated with an application present on the device. *Sragner* and *Oprescu-Surcode* are distinct as are the needs each of these inventions are attempting to surmount. Accordingly, *Sragner* and *Oprescu-Surcode* are not properly combinable references.

Claims 9 and 17 are not unpatentable over *Sragner* for at least the same reasons that claim 1 is not unpatentable over *Sragner*. Claims 2, 3, and 5-8 depend from claim 1 and are therefore not unpatentable over *Sragner* for at least the same reasons. Claims 10, 11, and 13-16 depend from claim 9 and are therefore not unpatentable over *Sragner* for at least the same reasons. Claims 18, 19, and 21-24 depend from claim 17 and are not unpatentable over *Sragner* for the same reasons.

Claims 4, 12, and 20 were rejected as being unpatentable over *Sragner* in view of *Oprescu-Surcode*. Claims 12 and 20 are not unpatentable over *Sragner* in view of *Oprescu-Surcode* for at least the same reasons that claim 4 is not unpatentable over *Sragner* in view of

Oprescu-Surcode. Claims 4, 12, and 20 depend upon claims 1, 9, and 17 respectively and are therefore not unpatentable over *Sragner* in view of *Oprescu-Surcode* for at least the same reasons that claim 1, 9, and 17 are not unpatentable over *Sragner* in view of *Oprescu-Surcode*.

CONCLUSION

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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